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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,103	03/16/2001	James A. Johanson	A2550.0002/P002	8930

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EXAMINER	
WEAVER, SCOTT LOUIS	
ART UNIT	**PAPER NUMBER**
2645	11

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)	
	09/809,103	JOHANSON ET AL.	
	Examiner	Art Unit	
	Scott L. Weaver	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 February 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23 and 25-36* is/are rejected.

7)☐ Claim(s) *24* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's arguments filed 2/17/2004 have been considered but they are not fully persuasive.

Claim Objections

2. Claim 13, and 17-23 are objected to because of the following informalities: ***. Appropriate correction is required.

In claim 13, (ln.9) "a main" should be –the main--.

In claims 17-23, each of the claims refer to "said commands" of claim 16, claim 16 uses "said entered commands", for consistent and definite intent of referring to these same commands, consistent terminology of "said entered commands" should be used in claims 17-23.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-12, and 27-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention..

In claim 1, (ln.3) "thereof" causes confusion with respect to what is definitely being referred to, it is not clear if 'thereof' intends to refer to the 'main telephone

answering device' or to the 'first control circuit', further confusion arises in that the claim limitations now suggest the a first control circuit responds with a busy signal when unable to process a command , it i snot clear if this is as intended or where the proper support for this limitation is provided in the original disclosure. On (ln.7-8) it is not clear if the limitation intends to state an extension answering device 'is incapable of initiating a telephone call [,]' or is merely 'incapable of initiating a telephone call that sends said command', use of commas (,) may help avoid confusion in this respect.

In claim 3, "said external command" (ln.2)_ lacks antecedent basis.

In claim 9, reference to "said command" is indefinite and appears incorrect as written, in that this refers to the command of claim 1, it is not clear if this should refer to the command introduced in claim 9, or to the command previously referred to in claim 1 as is written, as written, the claim causes confusion with claim 1 because the claim 1 says that the response is a busy signal, while claim 9 states that the response is to stop.

In claim 27, use of the "/" in "enablement/disablement" is indefinite in that it is not clear if this intends to refer to "and", "or" or both "and and or".

In claim 33, "said wireless communications link" lacks antecedent basis.

Claim Rejections - 35 U.S.C. § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
(e) the invention was described in-
(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

6. Claims 27-32, and 35-36 are rejected under 35 U.S.C. 102(a) as being clearly anticipated Bertocci et al. (#6, 148,213).

Bertocci teaches a main telephone answering device with control circuit and transceiver circuitry to communicate wirelessly with an extension answering device having second control and transceiver circuitry via (figure 4-6; col.1,ln.33-col.2,ln.3; col.2,ln.54-col.3,ln.11; col.3,ln.51-col.4,ln.6; col.4,ln.30-col.5,ln.16; col.9,ln.5-14). The extension device is enabled to screen incoming calls answered by the main unit without user intervention, as well as enabled to interrupt screened calls being monitored so that message recording will stop as well as enabled to control all of the functions of the main answering unit from the extension device.

With further respect to the remarks of the response (paper #10 filed 2/17/2004), the wireless extension device of Bertocci is not capable of initiating g telephone call [when the telephone line is being used], the claim does not make a statement as to when the capability being claimed is or is not excluded.

7. Claims 13-18, 20-23, and 27-32, are rejected under 35 U.S.C. 102(a) as being clearly anticipated Kite (#6,104,923).

Kite clearly teaches via (for example col.13,ln.7-50; col.14,ln.5-26) the remote controller extension answering device with a main answering device communicating wirelessly therewith to screen incoming calls and control the main answering unit as claimed.

With respect to the remarks of the response (paper #10 filed 2/17/2004), the remarks indicate that the reference does not teach "complete" enablement or disablement independent of

the remote, however, the claims do not state to what degree or specific functions the enablement or disablement includes or excludes. Kite does teach the volume control on the main unit and this is a function of call screening, as such it is independent of disabling or enabling from the remote.

Claim Rejections - 35 U.S.C. § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 25-26, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kite in view of Ekel et al. (#US2002/0002707).

Kite clearly teaches that which is pointed out above as pertains to claims 13, and 27 from which claims 25-26, depend.

Kite does not teach the use of a Bluetooth compliant communication for the wireless communication between the extension and main unit as per claims 25-26.

Ekel teaches to use Bluetooth compliant wireless transmission for a remote control of a main device for control of audio, (Paragraphs [0023-0025]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Bluetooth compliant wireless transceiver and control circuitry as taught by Ekel for use in the remote control of Kite for the reason that Bluetooth is a preferred wireless technology due to ready availability of components for use with therewith.

In response to the remarks of (paper #10 filed 2/17/2004), the remarks point out suggested differences of only the primary reference Kite, as such, in view of the remarks above with respect to Kite, no further comments are considered necessary

10. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kite in view of Sacher et al. (WO 94/27394).

Kite does not teach one of the functions of the answering machine is to be able to transfer messages to other of multiple mailboxes define in the main answering unit.

Sacher teaches to enable a user to transfer a message to an alternative mailbox of multiple mailboxes on the main unit via (page 13).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the main answering unit of Kite to include a command accessible to remote as well as main unit such that multiple mailboxes for users were provided and the command could enable the transfer of messages amongst mailboxes as taught by Sacher for the purpose of enabling multiple users to receive private messages and to transfer desired messages to other persons associated therewith as desired.

In response to the remarks of (paper #10 filed 2/17/2004), the remarks point out suggested differences of only the primary reference Kite, as such, in view of the remarks above with respect to Kite, no further comments are considered necessary

Conclusion

11. The prior art made of record and not relied on is considered pertinent to the claimed subject matter, the prior art of record at this time does not clearly teach or fairly suggest to one of ordinary skill in the art that which is as provided via claim 24 including the combination as claimed and those claims would be allowable if rewritten to include the limitations of the base and intervening claims. The definite patentability of claims 1-12 and 33-34 can not be determined at this time due to the confusion noted above, claim 1 does suggest portions of the previous limitations of claim 3 and it is probable that claim 1 would be indicated allowable if the proper function of previous claim 3 was properly incorporated into independent claim 1 and if all the claims were rewritten to avoid the confusion noted.

12. Applicant's amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott L. Weaver whose telephone number is 703-308-6974. The examiner can normally be reached on Tuesday to Friday 8 AM to 6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SCOTT L. WEAVER
PRIMARY EXAMINER
Art Unit 2645